

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Philip S. Siegel
U.S. Patent Serial No.: 10/750,935
Filing Date: January 2, 2004
Group No.: 3627
Examiner: Mussa A. Shaawat
Confirmation No.: 1902
Title: ON-LINE RULES-BASED RETURN PROCESSING

Mail Stop Notice of Appeal

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal.

In the prosecution of the present Application, the PTO’s rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action dated November 20, 2008 (the “*Final Office Action*”) to establish a prima facie rejection of at least independent Claims 1, 15, 17, 19, 20, 21, 22, 24, and 26 and dependent Claim 9 under 35 U.S.C. § 103(a). In this Pre-Appeal Brief Request for Review, Applicant requests panel review of the identified claims.

I. The Final Office Action is Incomplete

In each of the past three Office Actions, the Examiner has failed to provide an explicit rejection of independent Claims 22, 24, and 26. Although the Examiner provides an explicit rejection of Claim 1, the Examiner merely states with regard to Claims 22, 24, and 26 that the limitations of these claims “are similar to the limitations of Claims 1 and 25, therefore [Claims 22-, 24, and 26] are rejected based on the same rationale.” (See, for example *Final Office Action*, page 6; see also, the Office Action dated May 1, 2008, page 6; see also, the Office Action

dated November 19, 2007, page 7). It has been and continues to be Applicant's position that Claims 22-27 recite claim elements that are distinct from Claims 1 and 25. Specifically, Applicant has repeatedly provided arguments explaining in detail the deficiencies of the cited references with regard to Claims 22-27. (See, Response to Office Action submitted on July 31, 2008, pages 12-14; Response to Office Action submitted on January 22, 2008, pages 18-29; see also, Response to Office Action submitted on January 22, 2008, pages 16-18). Applicant has also expressed disagreement with the Examiner's characterization of Claims 22-27 as being "similar to the limitations of Claims 1 and 25." (See, Response to Office Action submitted on July 31, 2008, pages 11-12; Response to Office Action submitted on January 22, 2008, pages 18-29). Despite Applicant's requests for reconsideration, the Examiner has failed to address Applicant's arguments and, more importantly, has failed to acknowledge the distinctions between Claims 22-27 and Claims 1 and 25 by providing distinct and appropriate rejections of these claims.

For at least these reasons, Applicant submits that the *Final Office Action* is incomplete and deficient on its face.

II. **Independent Claims 22, 24, and 26 are Allowable**

The rejection of independent Claims 22, 24, and 26 is improper at least because the proposed *Arganbright-Roman-Cybul* combination fails to disclose, teach, or suggest "transmitting a client identifier to a client system associated with the customer;" "in a second transaction, receiving, via the Internet, a return request . . . comprising the client identifier that uniquely identifies the client system from which the return request is received," and "using the client identifier to identify the customer-specific return information." In the *Final Office Action*, the Examiner identifies no reference as specifically disclosing the recited claim elements (*Final Office Action*, page 6), and it is Applicant's position that no reference on record can be cited as disclosing the recited claim elements.

Arganbright merely discloses "a system and method for providing complete electronic commerce ("E-Commerce") transactions and solutions for a marketing company's products via the World Wide Web." (Abstract). According to *Arganbright*, "an individual may register with the marketing system as a Client, a Member, or a Member Plus." (Column 2, lines 26-27). A client is eligible to buy products at a Client price, a member is eligible to buy products at a Member price, and a member plus is eligible to buy products at a Member Plus price. (Column 2, lines 27-32). Thus, the *Arganbright* system offers variable prices to customers based on the customer's status. "Client" as used in *Arganbright* refers to the customer. It does not refer to a

client system. Additionally, although *Arganbright* briefly discusses a “process for handling returns” (Column 62, line 51 through Column 63, line 55), there is no disclosure in *Arganbright* of obtaining from a return request a “client identifier that uniquely identifies the client system from which the return request is received” or of “using the client identifier to identify customer-specific return information.” At least these elements are absent from the disclosure of *Arganbright*.

The deficiencies of *Arganbright* are not cured by the additional disclosures of *Roman* and *Cybul*. *Roman* merely discloses that a customer is “asked a series of questions about the return” to obtain information “such as receipt number, consumer’s name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition.” (*Roman*, Page 1, paragraph 0015). Thus, the information is obtained from the customer and does not include a client identifier associated with a client system.

Likewise, *Cybul* also does not disclose the recited claim features and operations. *Cybul* relates to a system for online shopping that “takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line. There is no disclosure of a client identifier associated with a client system.

Accordingly, *Arganbright*, *Roman*, and *Cybul* (and their proposed combination) do not disclose obtaining from a return request a ““transmitting a client identifier to a client system associated with the customer;” “in a second transaction, receiving, via the Internet, a return request . . . comprising the client identifier that uniquely identifies the client system from which the return request is received,” and “using the client identifier to identify the customer-specific return information,” as recited in Claims 22, 24, and 26. For at least these reasons, the rejections of Claims 22, 24, and 26 should be withdrawn.

III. Claims 1, 15, 17, and 19-21

The rejections of independent Claims 1, 15, 17, and 19-21 are improper at least because the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest “receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing,” as recited in Claim 1. In the *Final Office Action*, the Examiner relies specifically on *Cybul* for disclosure of the recited claim elements. (*Final Office Action*, page 3). Applicant respectfully disagrees.

Cybul merely discloses a system for online shopping that “takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor’s POS system “supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer,” the information may be extracted from the vendor’s POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34). Thus, the selection referred to by *Cybul* is performed by a server-based “list builder tool.” The application finds and selects items previously purchased by the customer. The selection is not by a customer, is not a click on the particular item of merchandise, and does not identify a particular item of merchandise for returns processing. Accordingly, *Cybul* does not disclose “receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing,” and, thus does not cure the deficiencies of *Arganbright* and *Roman*. The recited claim elements are absent from the cited references.

For at least these reasons, the rejection of Claims 1, 15, 17, and 19-21 should be withdrawn.

IV. Claim 9

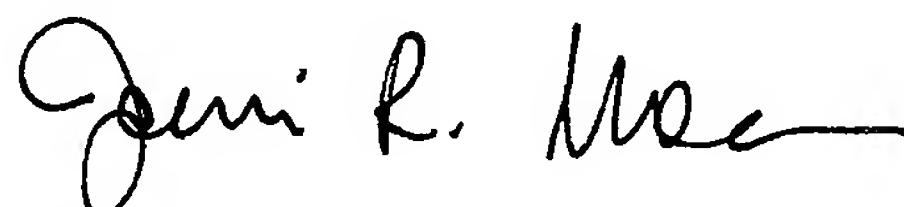
Dependent Claim 9 recites that “the processing step is performed by crediting an account of the customer.” The Examiner identifies no reference as specifically disclosing the recited claim elements and instead takes Official Notice that the claim elements are well known and old in the art. (*Final Office Action*, page 5). Applicant traverses the Examiner’s taking of Official

Notice. The M.P.E.P. states that Official Notice is only appropriate "provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection." (M.P.E.P., §2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.). Such is not the case here. The recited claim elements do not "fill in the gaps" of *Arganbright*, *Roman*, and *Cybul*. Additionally, the Examiner has provided no evidence to support the Examiner's contention that Applicant's customer information comprising "the processing step is performed by crediting an account of the customer," as recited in Applicant's dependent Claim 9, is indeed "old and well known" in the art. In this case, it would not be appropriate for the examiner to take official notice of the claim elements of Claim 9 without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P., §2144.03).

CONCLUSION

For the reasons discussed above, Applicant respectfully contends that the final *Office Action* is deficient with respect to at least independent Claims 1, 15, 17, 19, 20, 21, 22, 24, and 26 and dependent Claim 9. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts LLP.

Respectfully submitted,
BAKER BOTTS L.L.P.



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